

## **REMARKS/ARGUMENTS**

### **Status of Application**

Claims 1-16 remain in this application. Claims 1, and 3-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,737,539 to Edelson et al. Applicants have amended independent claim 1 to clearly recite a system for accessing pharmacy data and ordering prescriptions via a network that includes an application server that allows customers to access information concerning drugs and personal information, as well as enabling each of the customers to transmit a prescription order to either at least one of a plurality of member pharmacies or one of one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities. This amendment does not raise any new issues that would require further consideration and only clarifies further the elements previously present in the claims.

Specifically, applicants added the words "either" "or" and "or both" to clarify that the transcription order may be sent to either one of the member pharmacies, or one of the one or more shipping facilities, or both, thus clarifying that the claim is intended to also include a combination of the alternatives. Applicants also added the words "so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities" at the end of independent claim 1 to ensure that it is clear that at least one prescription drug associated with a prescription order is shipped from a shipping facility as a result of the transmission of the prescription order. Because the words added to the elements previously present in the claims only add clarity to the claims, no new search is required.

Applicants respectfully traverse the rejections and requests reconsideration.

### **Claims 1-8**

It is respectfully submitted that Edelson et al. does not disclose a system that is connected to one or more shipping facilities, and in particular, Edelson et al. does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, nor does it disclose an application server that is configured to allow

customers to access information concerning drugs and personal information concerning each respective customer and to enable each of the one or more customers to transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities.

Edelson et al. generally discloses a professional data management system, and in particular, a computer-implemented prescription management system to assist physicians in prescribing and reviewing drugs. It is respectfully submitted that the Edelson et al. does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities. While the paragraphs in Edelson et al. identified by the examiner disclose a "host computer facility 206 comprising ... a file server or database management server, or cluster of such servers ... providing high volume data availability to multiple intelligent clients linked, typically over a local area network, to the server or servers", the identified paragraphs, as well as the whole of Edelson et al., do not disclose an intranet server that is connected to even one shipping facility.

It is also submitted that Edelson et al. does not disclose an application server that is configured to allow each of one or more customers to transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities. While Edelson et al. discloses "dosing schedules" and "shipping schedules," nowhere does Edelson et al. disclose allowing a customer to transmit a prescription order to either a pharmacy or a shipping facility or both.<sup>1</sup> And in particular, Edelson et al. does not disclose enabling a customer to transmit a prescription order so that at least one prescription drug associated with the prescription order is shipped from a shipping facility.

Additionally, it is submitted that Edelson et al. does not disclose a system that includes a database containing personal information concerning one or more customers. Nor does Edelson et al. disclose allowing one or more customers to access their personal

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<sup>1</sup> The final Office Action did not point out in particular where Edelson et al. discloses transmitting a prescription order to one of the one or more shipping facilities. If the Examiner disagrees with Appellants' statements of what Edelson et al. does not disclose, he is respectfully invited to point out where such disclosure exists in Edelson et al.

information. While the system disclosed in Edelson et al. assists physicians in prescribing and reviewing drugs, it does not disclose a database containing personal information concerning one or more customers. The examiner argues that in Edelson et al., "the professional using the system is capable of creating a prescription for him/herself." However, the examiner does not mention that Edelson et al. discloses allowing the doctor to access a database that contains personal information about the doctor. Nor does such disclosure exist.

Furthermore, the system for accessing pharmacy data and ordering prescriptions via the network as originally recited in amended claim 1 includes (1) a network server that is accessible by one or more customers, (2) a database that contains information concerning drugs and personal information concerning one or more of the customers, and (3) an application server that is configured to allow each of the one or more customers to access the information concerning drugs and personal information concerning each respective customer of the one or more customers and enable each of the one or more customers to transmit a prescription order to either at least one of the plurality of member pharmacies or one of the one or more shipping facilities or both, so that at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities. It is submitted that Edelson et al. appears to only disclose allowing access to the system by physicians and "other medical professionals, especially those having prescribing authority." (Col. 51, ll 41-42)

In fact, Edelson et al. distinguishes between customers and professionals by the following: "[i]n a more general sense, the invention provides a service professional with significant new benefits, especially during a service encounter with a customer or client, in selecting, specifying or providing technical remedies to consumer problems." (Col. 51, ll 44-47; *see also* Col 5, l 66 to Col. 6, l 8 and Col. 52, ll 18-29) Nowhere in Edelson et al. does it appear to disclose allowing the actual customer to (1) access a network server, (2) access a database containing information concerning drugs and personal information of the customer, and (3) access an application server containing information concerning drugs and personal information concerning the customer and enable the customer to transmit a prescription order to either a member pharmacy or a shipping facility, or both.

Because no embodiment of Edelson et al. appears to disclose the invention recited in claim 1, it is submitted that claim 1 was not anticipated by Edelson et al.<sup>2</sup> In order for a claim to be anticipated under § 102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. See for example, C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device..."); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...").

Therefore, the invention recited in independent claim 1 is not anticipated by Edelson et al. It is respectfully submitted that claim 1 and claims 2-8 which depend therefrom are allowable over Edelson et al.

#### **Claims 9-16**

It is respectfully submitted that Edelson et al. does not disclose a method of enabling one or more customers to order prescriptions and access pharmacy data via a network that includes registering a customer with a network website and displaying to the customer on the website at least one of a prescription order selection and a pharmacy data access selection. The method also includes displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities, and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

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<sup>2</sup> If the Examiner believes there is an embodiment in Edelson et al. that incorporates all of the recitations of one of the claims, he is respectfully invited to point it out and explain how it includes all the recitations of the claim.

As noted in connection with claim 1, there does not appear to be any disclosure in Edelson et al. of (1) enabling one or more customers to order prescriptions and access pharmacy data via a network, (2) registering a customer with the network website, (3) displaying to the customer one of a prescription order selection and a pharmacy data access selection, (4) displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and (5) displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

Accordingly, it is submitted that claim 9, and claims 10 - 16 which depend therefrom, are not anticipated by Edelson et al.

### **Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

By 

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